



December 26, 2002

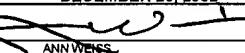
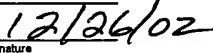
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Readhead et al.
 Serial No. 09/292,723
 Filed: April 15, 1999
 For: TRANSFECTION, STORAGE AND TRANSFER OF MALE
 GERM CELLS FOR GENERATION OF TRANSGENIC
 STEM CELLS
 Examiner: WOITACH, J. Unit: 1632

PETITION FOR REVIVAL OF PATENT
APPLICATION UNDER 37 C.F.R. §1.137(a)

RECEIVED
 JAN 03 2003
 OFFICE OF PETITIONS

BOX DAC
 Assistant Commissioner for Patents
 Washington, D. C. 20231
 Attention: Office of Petitions

CERTIFICATE OF MAILING	
I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO BOX DAC, ASSISTANT COMMISSIONER FOR PATENTS & TRADEMARKS, WASHINGTON, D. C. 20231.	
ON	DECEMBER 26, 2002
  ANN WEISS Date of Signature	

Dear Sir/Madam:

Petitioner, Cedars-Sinai Medical Center, hereby requests that the above patent application be revived under 37 C.F.R. 1.137(a) (authority from 35 U.S.C. § 133):

Where the delay in reply was unavoidable, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph.

Petitioner submits that the lack of submission of a response to the Office Action mailed on January 3, 2002, within the period for reply was unavoidable as required by 37 C.F.R. § 1.137(a). As set forth in detail hereinbelow, the delay in submitting a timely response to the January 3, 2002 Office Action was unavoidable since Petitioner's attorney did not timely receive (1) said Office Action, nor (2) a telephonic or written Notice of Abandonment regarding same.

I. PERTINENT FACTS

A. Petitioner's Status Check

Petitioner filed a Response to Office Action (mailed September 24, 2001), including a Terminal Disclaimer, and a Supplemental Amendment (mailed October 15, 2001); confirmatory postcards in Petitioner's files show that these were received by the

United States Patent and Trademark Office ("USPTO"). On November 6, 2001, Petitioner's undersigned attorney learned in a telephonic interview with Primary Examiner Deborah Crouch that in view of the departure of previous Examiner Jill Martin from the USPTO, the above-captioned application and a number of related applications would be reassigned to other examiners, and therefore Petitioner could expect a significant delay in further prosecution.

By late October 2002 no Office Action had been received in the above-referenced application, nor in Petitioner's related application 09/272,443. Petitioner's undersigned attorney instructed his assistant Ms. Ann Weiss to telephone the USPTO to inquire of the status of these two applications. A call was placed to Kay Pinkney at 703/305-3553, since according to the last received Office Action, issued April 24, 2001, "any inquiry of a general nature or relating to the status of this application should be directed [to her]". This was apparently an unassigned line. Ann Weiss then called Customer Service and spoke to a Mr. McCloud who informed Ms. Weiss that the Examiner to the above-referenced application was Examiner Woitach and, moreover, that an Office Action had been mailed to Petitioner's attorney on January 3, 2002. Ms. Weiss then called Supervisory Patent Examiner (SPE) K. Hauda (who was the Supervisor according to the April 24, 2001 Office Action). In a voice-mail message, Ms. Weiss was told that Ms. Hauda was no longer the SPE, but to call the new SPE, Deborah Clark at 703/305-4051. Ms. Weiss called the number given by Ms. Hauda's message. There was a voice mail message by Deborah Reynolds indicating that she was the SPE of Unit 1632. Ms. Weiss left a voice mail message to call Petitioner's undersigned attorney, Nisan A. Steinberg, regarding the status of the file. On November 7, 2002, Petitioner's undersigned attorney received a voice mail message from Supervisory Patent Examiner Deborah Reynolds confirming that both applications had been assigned to Examiner Joseph Woitach and providing his contact information.

B. Telephonic Conference with Examiner Woitach on November 7, 2002

After receiving the above-mentioned voice mail message from Supervisory Patent Examiner Reynolds, on November 7, 2002, Petitioner's undersigned attorney immediately contacted Examiner Woitach who told him that a final Office Action had been issued in the above-referenced application on January 3, 2002, and that no response had been received by the USPTO. Consequently, as of July 3, 2002, the above-captioned application had technically become abandoned. (The Examiner stated that no Office Action had yet been issued in the second application 09/272,443, which the Examiner told Petitioner's undersigned attorney, seemed to have "fallen through the cracks." Consequently, the Examiner said an Office Action would be issued in 09/272,443 soon.)

Petitioner's undersigned attorney informed Examiner Woitach that the Office Action, issued January 3, 2002, had never been received and that neither had

any written Notice of Abandonment been received from the USPTO. Petitioner's undersigned attorney also indicated to the Examiner that he had never received the standard phone call from the USPTO in which the examiner asks whether an Petitioner is in fact abandoning the application. Examiner Woitach admitted that the USPTO had neither telephoned Petitioner's attorney concerning abandonment, which the Examiner said is the normal procedure when a timely response is not received in the USPTO by the statutory deadline, nor had a written Notice of Abandonment been issued by the USPTO. Examiner Woitach told Petitioner's undersigned attorney that he thought a Petition to Revive the application would likely be granted in view of the prosecution history, if detailed evidence could be provided that indeed the Office Action had not been received by Petitioner.

Accordingly, Petitioner submits this petition to revive the above-captioned application. Exhibit A appended hereto is the Declaration of Mr. Larry Gordon. Mr. Gordon is a Legal Assistant at Sidley Austin Brown & Wood LLP, who was responsible for processing mail received from the USPTO during the period from approximately November 15, 2000 to approximately April 1, 2002. In his declaration (Exhibit A) Mr. Gordon describes the routine procedures he followed in processing incoming mail and which have been followed subsequently. Mr. Gordon's declaration includes a copy of the log of incoming patent office communications for the first ten months of 2002, which shows that the Office Action was not received by Petitioner's attorney.

C. Response to Office Action mailed January 3, 2002

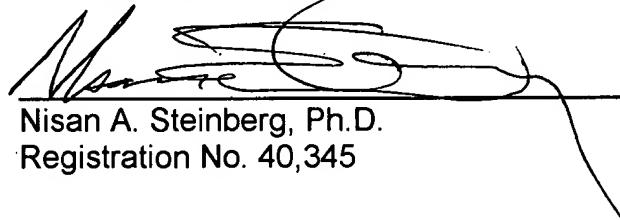
On November 8, 2002, Petitioner's undersigned attorney requested in a voice mail message to Examiner Woitach that a copy of the Office Action be sent by facsimile so that Petitioner could prepare and file the requisite response, pursuant to 37 C.F.R. § 1.137(a)(1), along with the petition, which request Examiner Woitach kindly fulfilled on November 11, 2002. Therefore, enclosed for filing upon approval of this Petition is a Response to the Office Action, mailed January 3, 2002.

D. Relief Sought and Conclusion

Petitioner submits that it has adequately shown that the delay in responding to the Office Action dated January 3, 2002 was unavoidable, since subsequent to the departure of former Examiner Jill Martin, Petitioner and Petitioner's attorney were unaware that a new Examiner had been assigned and that an Office Action had been issued until so informed in November 2002, as described hereinabove. As soon as it became aware of these facts, Petitioner promptly prepared and filed this Petition along with a Response to Office Action. Therefore, Petitioner respectfully requests that its Petition to revive the above-captioned application be granted and the Response to Office Action filed herewith be considered.

The Commissioner is hereby authorized to charge the Petition fee of \$130.00 and any other fees required in the processing of this Petition or the consideration of Petitioner's Response to Office Action submitted herewith, or to credit any overpayment to Deposit Account No. 50-1597.

Respectfully submitted,



Nisan A. Steinberg, Ph.D.
Registration No. 40,345

Sidley Austin Brown & Wood LLP
555 West Fifth Street
Los Angeles, California 90013-1010
Telephone: (213) 896-6665
Facsimile: (213) 896-6600

EXHIBIT A



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Readhead et al.
 Serial No. 09/292,723
 Filed: April 15, 1999
 For: TRANSFECTION, STORAGE AND TRANSFER OF MALE GERM CELLS
 FOR GENERATION OF SELECTABLE TRANSGENIC STEM CELLS
 Examiner: Woitach, J.
 Unit: 1632

DECLARATION OF LARRY GORDON IN SUPPORT OF PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)

I, Larry Gordon, have personal knowledge of the following facts:

1. I am a citizen of the United States of America, residing at 43260 30th Street West, Lancaster, California, 93536.

2. I am a Legal Assistant in the Los Angeles office of Sidley Austin Brown & Wood LLP, at 555 West 5th Street, Los Angeles, California 90013, and have been since November, 2000. In this capacity, I was responsible for processing mail received from the United States Patent and Trademark Office ("USPTO") from approximately November 15, 2000 to approximately April 1, 2002.

3. The procedure for processing mail, including all correspondence received from the USPTO, which I routinely followed during this period, consisted of opening the mail, date stamping and electronically scanning the mail, and electronically transmitting a copy of the scanned mail as an attachment to our patent prosecution docketing center in the Dallas office of Sidley Austin Brown & Wood LLP, for input into our PATTSY docketing system. In addition, I routinely stored a copy of all such transmissions on my computer hard drive in an email folder named "Scanned Mail".

4. After April 1, 2002, Shanna Chustz, residing at 4122 Hillcrest, Los Angeles, California 90008, assumed responsibility for processing mail received from the U.S. Patent and Trademark Office, following the same procedures that I have described hereinabove. In addition, she has routinely followed the procedure of transmitting a copy to me of each email to our Dallas office, which contains the scanned correspondence that we have received from the USPTO. I have continued routinely to maintain an electronic record of all such correspondence received from the USPTO, whether initially processed either by myself or by Shanna Chustz, in the same email folder entitled "Scanned Mail", mentioned hereinabove.

5. I have no recollection, nor any documentary record, neither in hard copy nor electronic version, of our office ever having received an Office Action or any other correspondence from the USPTO during the month of January, 2002, or in any of the subsequent months until the present, for the above-captioned application 09/292,723 (current Attorney Docket No. "18810-80334", formerly "P07 41795" or "041795US"). Accompanying this Declaration is **Exhibit 1**, which contains a printout listing each of the emails (plus attachments) contained in my above-mentioned email folder "Scanned Mail", listed by application serial number and/or attorney docket number, for the period January 2002 until the present. The above-captioned application is entirely absent from this complete list.

6. In addition, I have personally and thoroughly searched our prosecution docket received from our Dallas Office and have found no evidence that during 2002 any USPTO Office Action nor any other USPTO Communication was received and put into the PATTSY docketing system, concerning the above-captioned application, as would have routinely occurred had such correspondence been received.

Executed this 14th day of November, 2002.

By: 

Larry Gordon
Legal Assistant

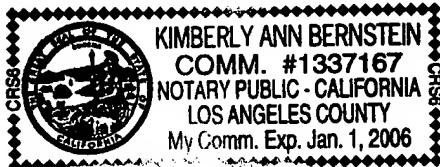
SIDLEY AUSTIN BROWN & WOOD LLP
555 West Fifth Street
Los Angeles, California 90013-1010
Ofc: 213/ 896-6000
Fax: 213/896-6600

STATE OF CALIFORNIA)
COUNTY OF LOS ANGELES)

On November 14, 2002, before me, Kimberly Ann Bernstein, Notary Public in and for said State and County, personally appeared Larry Gordon, personally known to me or proved to me on the basis of satisfactory evidence to be the person whose name is subscribed to the attached instrument and acknowledged to me that he executed the same in his authorized capacity, and that by his signature on the instrument, the person or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Kimberly Ann Beuster



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EXHIBIT A1

			Fr m	Subject	Received
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